
To: Pamela Jean Bowman (p.j.bowman@tcu.edu)
Subject: TRADEMARK APPLICATION NO. 78161583 - DESERT ROSE - N/A
Sent: 9/20/04 1:45:46 PM
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/161583

APPLICANT: Pamela Jean Bowman

CORRESPONDENT ADDRESS:
Pamela Jean Bowman
4401 Quail Trail #305
Fort Worth TX 76114



RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

MARK: DESERT ROSE

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:
p.j.bowman@tcu.edu

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

Applicant: Pamela Jean Bowman
Trademark: DESERT ROSE
Serial No.: 78/161583
Attorney: n/a
Address: 4401 Quail Trail #305
Fort Worth, TX 76114

: BEFORE THE
: TRADEMARK TRIAL
: AND
: APPEAL BOARD
: ON APPEAL

TRADEMARK EXAMINING ATTORNEY'S BRIEF

The applicant has appealed the trademark examining attorney's final refusal to register the mark DESERT ROSE in connection with "perfume, perfume spray, cologne, cologne spray, toilet water, hand cream, bath soap, bath crystals, body lotion, body powder, shower gel, men's cologne, men's cologne

spray, hair spray.” The examining attorney refused registration on the Principal Register pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) because the applicant’s mark is likely to be confused with the mark in Registration No. 2,191,416, for DESERT ROSE, in connection with “depilatory wax.”

STATEMENT OF FACTS

Asserting a bona fide intention to use the mark in commerce, Application Serial No. 78/161,583 was filed on September 6, 2002 for the mark DESERT ROSE, in connection with “perfume, perfume spray, cologne, cologne spray, toilet water, body cream, hand cream, bath soap, bath crystals, body lotion, body oil spray, body oil, body powder, body glistener, shower gel, men’s cologne, men’s cologne spray, aftershave lotion, aftershave balm, body deodorant, shampoo, hair conditioner, hairspray.” On March 11, 2003, the examining attorney refused registration pursuant to Section 2(d) of the Trademark Act. In response, on August 8, 2003, the applicant deleted “body oil spray, body oil...body glistener... aftershave lotion, aftershave balm, body deodorant, shampoo, [and] hair conditioner.” Upon consideration of: 1) the identical nature of the marks; 2) the close relationship of the goods; and 3) the presumption that the respective goods will be encountered within the same or similar channels of trade, a final refusal was issued on November 10, 2003.

This appeal ensued on August 2, 2004. Applicant has traversed the refusal by arguing principally that the goods are unrelated.

ISSUE

The sole issue on appeal is whether or not the applicant’s mark, DESERT ROSE, is confusingly similar to the mark in Registration No. 2,191,416, DESERT ROSE, when used on the identified goods.

ARGUMENT

I. THE MARKS ARE IDENTICAL IN SOUND, APPEARANCE AND MEANING.

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark that it is likely, when applied to the goods, to cause confusion, or to cause mistake or to deceive. TMEP section 1207.01. The Court in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarities of marks as to appearance, sound, meaning, and commercial impression, as well as the similarity of the goods. Any one of these factors may be dominant in a given case, depending upon the evidence of record. In this case, the following factors are most relevant: the similarity of the marks, the similarity of the goods, and similarity of the channels of trade for the applicant's goods and the registrant's goods and services.

Applicant's mark, DESERT ROSE, is identical in sound, appearance and meaning to the registrant's mark, DESERT ROSE. The marks are both in typed form. Therefore, both may be depicted in the same stylization, font and size to maintain the same commercial impression. Because the marks are a combination of the same two words, prospective consumers are likely to be confused.

II. THE MARKS ARE USED ON CLOSELY RELATED GOODS.

If the marks of the respective parties are identical, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Ancor, Inc. v. Ancor Industries, Inc.*, 210 USPQ 70 (TTAB 1981). Further, the goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and/or services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

The relationship between the goods at issue is close. The applicant's goods are "perfume, perfume spray, cologne, cologne spray, toilet water, hand cream, bath soap, bath crystals, body lotion, body powder, shower gel, men's cologne, men's cologne spray, hair spray." The registrant's goods are "depilatory wax[es]."

The applicant argues that "depilatory waxes and perfumes are not used together." However, the applicant's goods are not limited to perfumes. The applicant also seeks registration for various creams, lotions and shower gels.

Despite considerable research on the issue, the examining attorney is unaware of any Trademark Trial and Appeal Board decision that deals directly with whether or not there is a likelihood of confusion when the same mark is used on perfumes, lotions, bath soap and the like versus depilatories. However, the Board has held that there is a likelihood of confusion on similar marks for "bath salts" and "toilet soap, shaving soap, shaving cream for use before shaving, and shampoo soap." *The American Products Company, et al. v. The Eusey Co. (Coffee Products of America, Inc., Ltd.)*, 46 USPQ 484 (Comm'r Pats, 1940). If a likelihood of confusion was found to exist in this situation, the examining attorney submits that a likelihood of confusion exists with regard to the applicant's and registrant's identical marks in conjunction with perfumes, lotions and soaps and depilatory waxes, respectively. This is especially so since depilatories are used for the same purpose as shaving creams and lotions, i.e., to remove unwanted hair.

Additionally, the previously attached printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely "perfume, perfume spray, cologne, cologne spray, toilet water, hand cream, bath soap, bath crystals, body lotion, body powder, shower gel, men's cologne, men's cologne spray, hair spray," and "depilatory wax[es]," are of a kind that may emanate from a single source. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001), citing *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). Specifically, under the EPI-SPA mark, the applicant manufactures "depilatory creams," and "lotions...[and] body sprays." Registration No.

2,707,118, a design mark owned by Reckitt & Colman, is registered for "depilatory preparations and waxes," along with "cosmetic creams and lotions for the face and body" and the like. As indicated in the Final refusal, dated November 10, 2003, there were 314 such registrations that demonstrate the similarity between the goods. Therefore, applicant's contention that its goods would not be confused is unsupported.

Additionally, the fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. See *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984), and cases cited therein; TMEP §§1207.01 *et seq.* From a practical standpoint, the products are of a kind that would be used by the same consumers. Specifically, women consumers are the ones most likely to use depilatory waxes and perfumes^[1] on any given day. Therefore, while there is no evidence that the goods are sold in the same aisle, a consumer encountering the registrant's mark on depilatory waxes and viewing the applicant's identical mark on perfumes may mistakenly believe that the manufacturer of the one product is also the manufacturer of the other.

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-5 (TTAB 1980).

Based on the foregoing, the examining attorney submits that the goods are closely related in a manner that gives rise to a mistaken belief that they come from the same source.

CONCLUSION

The marks in question are identical and are used on similar goods. Therefore, a likelihood of confusion exists between the marks under Trademark Act Section 2(d). Accordingly, the examining attorney respectfully asks that the Board affirm the refusal to register the mark under Section 2(d).

Respectfully submitted,

/Tricia McDermott Thompson/
Trademark Attorney
Law Office 114
(703) 308-9114 x263

K. Margaret Le
Managing Attorney

[1] The examining attorney again notes that the applicant's goods are not limited to perfume, but are included.